

REMARKS

Applicants have submitted new claims 28 - 32. Applicants have canceled previously pending claims 21 - 27.

An election of species requirement was mailed on July 20, 2004. As noted previously, Applicants elect Species 1 and Subspecies A. The detailed reasons for transversal are in Section B below.

A. Telephone Conference

Applicants appreciate the courtesy extended by Examiner Savage in a telephone conference on August 18, 2004. In the telephone conference, Applicants explained to Examiner Savage that the described embodiments throughout the specification related to a filter head that was designed to be able to accommodate both, individually, a spin-on canister filter and a cartridge filter. Applicants' representatives explained to Examiner Savage that it is our intent to be able to get this inventive concept examined. Applicants' representatives expressed concern that the election of species requirement did not allow for examination of this concept. Applicants' representatives requested Examiner Savage to reconsider the logic of the election of species requirement, in view of the inventive concepts and in view of the newly proposed claims. A proposed set of claims was faxed to Examiner Savage on August 17, 2004. Dependent claim 30 was modified from the faxed, proposed claim, in order to ensure proper support in the specification.

1. Claimed Concepts and Support in the Specification

Applicants' representatives explained to Examiner Savage in the telephone conference that the theme described throughout this specification is a single filter head that has the proper structure that allows it to interchangeably receive two, distinct types of filter elements. As the specification, on page 5, lines 21 - 23, summarizes: "the filter head 44 can accommodate or operably receive, both types of spin-on canister filter 46 and bowl-cartridge filter 48, interchangeably, sequentially, and independently of each other."

The specification is full of descriptions of this inventive principle. Examples include: page 10, lines 1-4; page 13, lines 11-13; page 14, lines 19-21; page 15, lines 11-12. Further, the Abstract describes how the method includes: "operably installing one of the spin-on canister filter and the bowl-cartridge filter onto the filter head to provide a filter assembly. After a period of use, the spin-on canister filter or bowl-cartridge filter is removed and replaced. The replacement can include, interchangeably, a spin-on canister filter and a bowl-cartridge filter."

In claim 32, there is a claim that the threaded connection (which is claimed as being the filter threaded region threadably engaged to the outer tube threaded region) has a cross-sectional thickness no greater than 10 mm. Support for this limitation can be found at, for example, page 8, lines 20-21, which states, "The threaded region 103 has a total cross-sectional thickness of no more than 10 mm, often no more than 8 mm."

At least the above-identified places in the specification, and including the drawings, provide support for the new claims.

B. Request for Reconsideration of the Election of Species Requirement

If there is going to be an election of species requirement, it would be logical to identify the species between the four different filter head embodiments, namely, FIGS. 1-4; FIGS. 5-10; FIGS. 11-16 and FIGS. 17-20. The identification of species set forth in the July 20, 2004 Office Action is an unworkable result and does not allow for a fair examination of the inventive concept.

FIGS. 1-4 all show the same and common filter head. In FIGS. 1 and 2, the filter head is shown receiving a cartridge filter having a reuseable bowl holding a replaceable filter element; in FIGS. 3 and 4, this same, identical filter head (the same one shown in FIGS. 1 and 2) is illustrated being used with a spin-on canister filter. If there is going to be any type of restriction or election requirement, Applicants do not believe it is logical to divide the claims relating to FIGS. 1-4. Each of FIGS. 1-4 has the same, common subassembly -- a filter head. In FIGS. 1 and 2, the filter head is shown with a cartridge filter, while in FIGS. 3 and 4, the filter head is shown with a spin-on canister filter. The Examiner is strongly urged to reconsider the logic of the election of species requirement.

FIGS. 5-10 depict a second embodiment of a filter head. The difference between the filter head shown in FIGS. 1-4 and the filter head shown in FIGS. 5-10 is the location of the threads on the filter head. In the embodiment of FIGS. 1-4, the threads are along the outer surface of the outer wall of the filter head, while in the embodiment of FIGS. 5-10, the threads are along the inner surface of the outer wall of the filter head. Again, as fully explained in the specification, the filter head of FIGS. 5-10 is identical through the pictures of FIGS. 5-10. In FIGS. 5-6, the filter head is shown with a cartridge filter, while in FIGS. 7-8, the same, identical filter head depicted in FIGS. 5 and 6 is shown with a spin-on canister filter. It does not make sense to require an election of species dividing FIGS. 5 and 6 from FIGS. 7 and 8.

FIGS. 9 and 10 show the same, identical filter head as used in the embodiment of FIGS. 5, 6, 7, and 8. In FIGS. 9 and 10, there is a different embodiment of a spin-on canister filter that is being used with the same, identical filter head of FIGS. 5-8. The Examiner is requested to reconsider the election of species requirement dividing FIGS. 9 and 10 from the embodiment of FIGS. 5-8.

FIGS. 11-16 depict a third embodiment of a filter head that is structurally designed to be able to receive both, separately, a spin-on canister filter and a cartridge filter. FIGS. 11 and 12 show the use of the filter head with a cartridge filter. FIGS. 13 and 14 show the same filter head as FIGS. 11 and 12, but used with a spin-on canister filter. FIGS. 15 and 16 show the same, identical filter head as in FIGS. 11-14, and with a different embodiment of a spin-on canister filter. Again, because of the common subassembly of the filter head in each of FIGS. 11-16, the Examiner is requested to reconsider his election requirement, which divides up FIGS. 11-12 from FIGS. 13-14 from FIGS. 15-16.

FIGS. 17-20 show a fourth embodiment of a filter head that has the mechanical features allowing it to receive, separately, both a spin-on canister filter and a cartridge filter. FIGS. 17-18 show the filter head receiving a cartridge filter, while FIGS. 19-20 show the same, identical filter head as FIGS. 17-18 receiving a spin-on canister filter. The Examiner is encouraged to reconsider the election of species requirement and not split FIGS. 17-18 from FIGS. 19-20.

C. Generic Claims

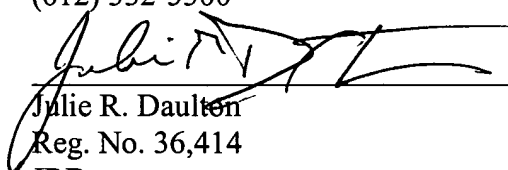
Each of claims 28 - 31 is believed to be generic. Each of the claims 28-31 relates to the concept of having a filter head that is capable of receiving, separately, both a spin-on canister filter and a cartridge filter. This is the case with each and every Figure identified by the Examiner in his election of species requirement. Dependent claim 30 relates to FIG. 21, which depicts the use of equipment having filter assemblies, as described in FIGS. 1-20. The filter assemblies are used in three contexts, a hydraulic system, a lubrication system, and a fuel system. For further explanation, the Examiner's attention is directed to page 4, lines 6-27.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the election requirement. Applicants request examination of all of the claims, withdrawal of the election requirement, and a Notice of Allowance.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,
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